



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,861	09/30/2003	Jeffrey P. Calibaba	ACCM:004US	1879

7590 10/04/2007
Michael C. Barrett, Esq.
FULBRIGHT & JAWORSKI, L.L.P.
Suite 2400
600 Congress Avenue
Austin, TX 78701

EXAMINER

RIVIERE, HEIDI M

ART UNIT	PAPER NUMBER
----------	--------------

3629

MAIL DATE	DELIVERY MODE
-----------	---------------

10/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/675,861

Applicant(s)

CALIBABA, JEFFREY P.

Examiner

Heidi Riviere

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. **Figures 1, 2 and 6** should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention as a whole must produce a "useful, concrete and tangible result." *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373-74, 47 USPQ2D 1596, 1601-02 (Fed. Cir. 1998). According to the Patent & Trademark Office Guidelines, the invention must produce a real-world result, it

Art Unit: 3629

must specifically recite a result and the claim must assure that this result is reproducible. *MPEP* § 2106.

Claims 1 does not produce concrete or tangible results. Claim 1 references the potential of two potential results.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1-2 and 4-5** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. **Claim 2** is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See *MPEP* § 2172.01. The omitted steps are: detailing how data is obtained and what data is being used.

The claimed method steps do not flow and are not linked together to a logical conclusion. They are not cohesive.

7. **With respect to claims 1-2:** A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See *MPEP* § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10

Art Unit: 3629

USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 1 recites the broad recitation "initial activities for setting up program", and the claim also recites "identifying a domain for program; developing a strategic plan for the program; presenting details for implementing program" which is the narrower statement of the range/limitation.

Furthermore, claim 2 recites the broad recitation "emergency services", and the claim also recites "PAD program" which is the narrower statement of the range/limitation.

8. **With respect to claim 1:** Claim 1 discloses two results "publicly proclaiming the domain a PAD community or organization if launching is successful" or in the alternative "mapping the domain as unsuccessful if launch is not successful". Examiner is uncertain of the metes and bounds of this claim and notes that the scope of the invention herein claimed is unclear. So, for the purpose of this examination these claims will refer to process of launching and publicizing the launch of a program.

9. **With respect to claims 4 and 5:** Claims 4 and 5 disclose both organization and domain. Within the specification a domain is considered an organization. Examiner is

Art Unit: 3629

uncertain of the metes and bounds of this claim and notes that the scope of the invention herein claimed is unclear. So, for the purpose of this examination these claims will refer to the organization and domain as on an equivalent basis.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claim 1** is rejected under 35 U.S.C. 102(b) as being anticipated by **Cannon (US 6,286,005 B1)**.

12. **With respect to claim 1:** Cannon teaches:

- identifying a domain for the program; (col. 30, lines 32-36 – demographic group is identified in terms of age, gender and other factors.)
- developing a strategic plan for the program; col. 31, lines 57-60; col. 32, lines 52-62 – initial plan is developed)
- conducting initial activities for setting up the program; (col. 30, lines 32-43; col. 32, lines 43-62 – initial planning entails defining demographic group, making sure program is cost effective and figuring out how to inform the audience)

Art Unit: 3629

- presenting details for implementing the program within the domain; (col. 30, lines 32-43 – initial planning entails defining demographic group, making sure program is cost effective and figuring out how to inform the audience)
- launching the program in the domain; (col. 31, lines 19-23 – campaign begins)
- publicly proclaiming the domain a PAD community or organization if launching is successful; and mapping the domain as unsuccessful if launch is not successful. (col. 31, lines 19-23 – after campaign begins the system is used to compare the planned versus actual objective)

Furthermore, the data identifying the public access defibrillation program (PAD) in the current and following claims is non-functional descriptive data.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Exemplary "functional descriptive material" consists of data structures and computer programs, which impart functionality when employed as a computer component. "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard

Art Unit: 3629

claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data identifying the selectable options and the information displayed upon selection of each option adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying the selectable options and the information displayed upon selection of the options does not functionally relate to the substrate and thus does not change the steps

Art Unit: 3629

of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 2- 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cannon** in view of **Dave Downey “San Diego-area Planning Agency Launches Campaign to Curb Traffic Congestion”** Knight Ridder Tribune Business News, July 7, 2002 (hereinafter “**Downey**”).

15. **With respect to claim 2:** Cannon teaches presenting data from other organizations having a PAD program; (col.3, lines 60-64 –comparing data from other businesses and networks) and

However, Cannon does not teach while Downey discloses:

- completing a questionnaire regarding emergency services; (page 2, paragraph 2 – visitors to the web site fill out a questionnaire to obtain a benefit match)
- providing an initial group with an overview of the program; (page 2, paragraph 2 – visitors are given “results overview” of eligible programs)

- reviewing the questionnaire with the initial group; (page 2, paragraph 2 – questionnaire results are given to visitors)
- identifying obstacles surrounding implementation of the program; (page 2, paragraph 4 – to fulfill the needs of consumers program employees would have to "go to 20 different offices and fill out 30 different forms)
- identifying solutions to the obstacles; (page 2, paragraph 4 – using the computer)
- identifying program team members and PAD sites. (page 1, paragraph 5 – National Council for the Aging runs the program)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Cannon with the disclosure in Downey by having potential clients fill out questionnaire, identify obstacles surrounding implementation as well as identifying program members because it is necessary to collect information on the success of the program or to make sure all is going well.

Furthermore, the data identifying "emergency services" or "external defibrillators" in the current claims is non-functional descriptive data.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Exemplary "functional descriptive material" consists of data structures and computer programs, which impart functionality when employed as a computer component. "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Art Unit: 3629

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data identifying the selectable options and the information displayed upon selection of each option adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information

Art Unit: 3629

conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying the selectable options and the information displayed upon selection of the options does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

16. **With respect to claim 3:** Cannon teaches the limitation discussed above.

However, Cannon does not teach while Downey discloses:

- updating a PAD coordinator regarding a current version of the program; (page 2, paragraph 5 – disk has updated information for consumers who control their own access to program) and
- guiding the coordinator through points identified in a project planner. (page 2, paragraph 5 – disk has updated information for consumers who control their own access to program)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Cannon with the disclosure in Downey by updating the PAD coordinator and also guiding the coordinator because of the need to make sure all parties are aware of what is happening with the program.

17. **With respect to claim 4:** Cannon discloses:

- activating membership of the program; (col. 30, lines 32-36 – demographic group is identified in terms of age, gender and other factors.)

Art Unit: 3629

- publicly proclaiming successful implementation of the program. (col. 31, lines 19-23 – after campaign begins the system is used to compare the planned versus actual objective)
- identifying a PAD project manager planner; (col. 30, lines 23-46 – media advertising planner oversees advertising initiative)

However, while Cannon does not Downey teaches:

- analyzing a domain's current condition with respect to PAD; (page 2, paragraph 4 – to fulfill the needs of consumers program employees would have to “go to 20 different offices and fill out 30 different forms)
- identifying a PAD team; (page 1, paragraph 5 – National Council for the Aging runs the program)
- giving a PAD presentation to an identified organization; (page 2, paragraph 5 – Chicago Community Trust made aware of program)
- proclaiming launch of the program with a media outlet; (page 2, paragraph 2 – discussing launch of program; Note: article about program launch)
- performing an annual review of the program; (page 2, paragraph 4 – review of program that lead to change)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Cannon with the disclosure in Downey by identifying the team, giving presentation and launching program because of the need to ensure the public and parties involved with the program are informed and aware of each other.

Art Unit: 3629

18. **With respect to claim 5:** Cannon teaches:

- activating membership of the program; (col. 30, lines 32-36 – demographic group is identified in terms of age, gender and other factors.)
- developing a strategic plan for the program; (col. 31, lines 57-60; col. 32, lines 52-62 – initial plan is developed)
- executing the strategic plan; (col. 31, lines 57-60; col. 32, lines 52-62 – initial plan is developed and carried out) and
- publicly proclaiming a successful implementation of the program. (col. 31, lines 19-23 – after campaign begins the system is used to compare the planned versus actual objective)

However, while Cannon does not San Diego teaches:

- identifying a PAD team; (page 1, paragraph 5 – National Council for the Aging runs the program)
- requesting identified organization to install automated external defibrillators; (page 2, paragraph 5 – each branch of organization is using program)
- announcing the program to the public; (page 2, paragraph 2 – discussing launch of program; Note: article about program launch)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Cannon with the disclosure in Downey by have a strategic plan and identify team and organization members and to announce the program for informational purposes and to alert the public.

Art Unit: 3629

CONCLUSION

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heidi Riviere whose telephone number is 571-270-1831. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm EST.;
Alternative Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

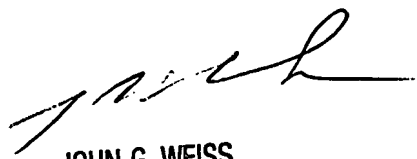
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Name: Heidi Riviere

Signature: 

Title: Examiner

Date: 9/20/07


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600